

REMARKS

Claims 1-18 are pending in this application.

Prior to addressing the objections and rejections set forth in the Office Action, it is respectfully noted that all future correspondence and telephone calls for this application are to be directed to Michael E. Carmen, M. CARMEN & ASSOCIATES, PLLC, 170 Old Country Road – Suite 400, Mineola, New York 11501. A copy of Change of Attorney's Address in Application, filed August 26, 2005, and the postcard showing receipt of the filed Change of Attorney's Address in Application are attached hereto.

In the Office Action, the Examiner indicated that Claims 8-12 have been objected to as being dependent upon a rejected base claim, but would be allowable over the prior art if rewritten in independent format including all of the limitations of the base claim and any intervening claim. Claims 8 and 11 have now been amended into independent format to include all of the limitations of the base claim and intervening claims. Thus, immediate allowance of Claims 8-12 is warranted and such is respectfully requested.

It is noted with appreciation the Examiner's indication in the Office Action that Claims 15-18 would be allowable over the prior art if rewritten in independent format including all of the limitations of the base claim and any intervening claim.

The Examiner has rejected Claims 1-7, 13 and 14 under 35 U.S.C. §102(b) as being anticipated by Carrick et al. U.S. Publication No. 2002/0147116 ("Carrick et al.").

Nowhere does Carrick et al. disclose or suggest "a high throughput method for screening lubricating oil compositions, under program control, comprising the steps of (a) providing a plurality of different lubricating oil composition samples comprising (i) a major amount of at

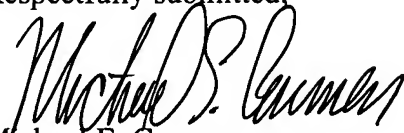
least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive; (b) measuring wear stability of each sample to provide wear stability data for each sample; and (c) outputting the results of step (b)” as presently recited in Claim 1.

Rather, Carrick et al. disclose a lubricating oil composition that contains additives that function as a complete or partial replacement for phosphorus-containing additives. Carrick et al. further disclose that the lubricating oil compositions can be individually tested for wear performance using, for example, the Motorized Valve Train Wear Test. However, it is well established that for a claim to be anticipated a single prior art reference must disclose each and every element of the claimed invention. *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 USPQ2d 1766, (Fed. Cir. 1987). At no point is there any disclosure or suggestion in Carrick et al. of a high throughput method for screening a plurality of different lubricating oil composition samples by measuring wear stability of each sample to provide wear stability data for each sample, under program control, and outputting the results. A high throughput method is an automated method that rapidly prepares and analyzes a relatively large number of different lubricating oil compositions, under program control, such that wear data of each sample is obtained. In lacking any disclosure or suggestion of a high throughput method for screening lubricating oil compositions under program control, Claims 1-7, 13 and 14 clearly possess novel subject matter relative to Carrick et al. Accordingly, withdrawal of the rejection under 35 U.S.C. §102(b) is respectfully requested.

Appln. No. 10/699,509
Amdt. dated February 17, 2006
Reply to Office Action dated November 25, 2005

For the foregoing reasons, Claims 1-18 as presented herein are believed to be in condition for allowance. Such early and favorable action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael E. Carmen", written in a cursive style.

Michael E. Carmen
Reg. No. 43,533
Attorney for Applicants

M. CARMEN & ASSOCIATES, PLLC
170 Old Country Road – Suite 400
Mineola, NY 11501
Phone: (516) 992-1848
Facsimile: (516) 739-0981
MEC:bg